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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,278	08/10/2000	Gholam-Reza Zadno-Azizi	PERCUS.1CP2C1	7079

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EXAMINER

BIANCO, PATRICIA

ART UNIT	PAPER NUMBER
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3762

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DATE MAILED: 09/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/636,278	Applicant(s) ZADNO-AZIZI ET AL.	
	Examiner Patricia M Bianco	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input checked="" type="checkbox"/> Other: <i>Detailed Action</i> |

DETAILED ACTION

Response to Preliminary Amendments

1. The amendment filed 6/30/03 amended portions of the specification and amended claim 55. Claims 43-64 remain pending.

Response to Arguments

2. Applicant's arguments with respect to claims 43-64 have been considered but are moot in view of the new ground(s) of rejection.

Inventorship

3. In view of the papers filed 6/30/03, the inventorship in this nonprovisional application has been changed by the deletion of **Mukund R. Patel** and **Ketan P. Muni**.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims **44-48, 51, 52, 54-56, 60, 61, 63 & 64** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunther et al. (5,329,942) in view of Nelson et al. (5,312,338).

Gunther et al. (hereafter Gunther) teaches of a catheter assembly (10) for use in occluding a vessel and filtering blood in the vessel. The assembly comprises a catheter (30), an expandable member (11) disposed on the distal end of the catheter, and a positioning assembly (12). The positioning assembly acts as the filter actuator. The assembly comprises a central wire (15), seen as the second elongate member, which passes through the catheter, and a sliding lock assembly (23), which also is comprised of a wire (14), and a cannula (22) that slides over the central wire. When the wire guide grasps the central wire, in a frictional manner, the filter is locked in the expanded configuration. The device has a fitting (45) at the proximal end to releasably lock the

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catheter and filter in the expanded configuration. The wire is longitudinally moved within the catheter to expand the filter. (See col. 3, line 39-col. 7, line 15; figs. 1-5).

Gunther discloses the invention substantially as claimed, however, fails to disclose that the positioning assembly further includes a rotational movement. Nelson et al. (hereafter Nelson) discloses a rotational tool for medical guidewires that also allows for longitudinal movement, said tool may be attached to a guidewire of a catheter for use in the vasculature. The device provides for two gripping modes. The guidewire is secured by the device, which is attached to the catheter, to permit both longitudinal and rotational movement of the guidewire. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the guidewire assembly to Gunther to provide the adjustability of having both longitudinal and rotational movement of the guidewire when needed at a particular instance or use by the user, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art.

6. Claims **49, 50, 53, 58, 59 & 62** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gunther ('942) & Nelson ('338) in view of Mische et al. (5,490,859). Gunther & Nelson discloses the invention substantially as claimed, see rejection supra, however, fail to disclose specifically the addition of a material that adjoins the expandable member, but does not completely encapsulate said member.

Mische et al. (hereafter Mische) teaches of an intravascular occlusion device comprising a collection portion (220) formed partially over an expandable member (16),

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either the distal or proximal end, depending on the area where particulate matter to be removed is located in relation to the occlusion. (Col. 23, line 45-col. 27, line 24; figure 17). It would have been obvious to one having skill in the art, at the time of the invention, to modify the braid apparatus of Gunther & Nelson to add a material to a portion of the expandable member such that said expandable member is partially covered to catch particulate that is removed from the vessel. Blood flow would be allowed to pass through the collection portion of the expandable member yet particulates would be stopped and held within for removal from the vessel.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **55-64** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **1-5 & 7-9** of U.S. Patent No. **6,312,407 B1**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are an obvious recitation of the

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invention than that of the issued patent, including all of the same limitations. The claims of the application claim a and the patent claims both claim a device for occluding a vascular segment comprising a tubular member, an expandable member on the distal portion of the tubular member, a elongate member having the distal end portion connected to the expandable member and extending longitudinally within the lumen of the tubular member for longitudinal movement between a first and a second position to cause the expandable member to go from a first, collapsed configuration to a second, expanded configuration, and further including a handle connected to the elongate member outside of the lumen of the tubular member having a profile in one dimension that is larger than a dimension of the lumen without extending radially substantially beyond an outer surface of the tubular member. Since a broad interpretation of patent claims 7/1 includes the claimed device of application claim 55, if a patent was to grant on the pending claims of this application applicant would be granted an unlawful extension of protection beyond the years of the '407 patent. Further, application claim 58 is identical to patent claim 2; application claim 59 is identical to patent claim 3; application claim 60 is identical to patent claim 4; application claim 61 is identical to patent claim 52; application claim 62 is identical to patent claim 8; application claim 63 is identical to patent claim 9.

Conclusion

8. Any inquiry concerning the rejections contained within this communication or earlier communications should be directed to examiner Tricia Bianco whose telephone

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number is (703) 305-1482. The examiner can normally be reached on Monday through Fridays, alternating Fridays off, from 9:00 AM until 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The direct fax number for the examiner is (703) 746-4876. The official fax numbers for the organization where this application or proceeding is assigned is (703) 872-9302 for regular communications and for After Final communications (703) 872-9303.

Tricia Bianco
Patent Examiner
Art Unit 3762

pmb 
September 20th, 2003